

Remarks:

5-6. The drawings are objected to for allegedly not showing the feature of a backer layer 20. The backer layer is shown, but not labeled, in FIG. 2 as filed. A replacement sheet is provided herewith in which the appropriate reference number for the backer layer 20 has been added to FIG. 2. No new matter has been added, since the backer layer 20 was originally explicitly disclosed in the as filed versions of FIG. 2 and paragraph [0019]. Therefore, it is respectfully requested that the objection to the drawings be removed.

7-8. Claims 1, 3-6 and 22-33 are rejected under the judicially created doctrine of obviousness-type double patenting. It is the understanding of the applicant that this rejection is temporarily held in abeyance pending the disposition of the claims. If applicant's understanding is inaccurate, please advise as to the status of this rejection.

9-10. Claims 1-2, 4-6 and 24-25 are rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Pat. No. 3,698,978 (hereinafter the " '978 Patent").

Present independent claim 1 recites a heat and pressure consolidated laminate that comprises in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting resin; and b) a first decorative layer consisting essentially of a leather material.

The Official Action contends that the '978 Patent discloses "*a high pressure laminate comprising core sheets, a decorative print sheets (sic), and overlay sheets. The core sheets are made of paper and impregnated with phenolic resin. The decorative print sheet and the overlay sheets are cellulosic and impregnated with melamine resin. The decorative sheet can be a simulated leather.* (See Figs 1-2; col. 1, ln. 24-35; col. 2, ln. 36-46; col. 3, ln. 20-50; Examples 1-2; claims 1-2)." (Official Action pg. 5; emphasis added).

However, it is respectfully submitted that the '978 Patent fails to anticipate claim 1 because the '978 Patent fails to disclose a feature of claim 1, that of "*a first decorative layer consisting essentially of a leather material.*" (cl. 1, emphasis added). In contrast, all throughout the '978 Patent, including at the cited locations in the Official Action noted above, the '978 Patent discloses a laminate including a print sheet comprising a cellulosic sheet and a pattern that provides an appearance that simulates leather. This print sheet is not actual leather material, as called for in claim 1. (See, for example, col. 1, lines 60-61; col. 2, lines 44-46, lines 67-68; col. 3, lines 20-23; and col. 4, lines 26-34).

The stated goal of the '978 Patent is to provide a high pressure laminate having an "irregular surface" appearance that can simulate natural products such as wood grain or leather. (col. 1, lines 43-53). To accomplish this goal, the '978 Patent discloses a laminate having a print sheet 10 (FIG. 1) made from a fibrous material "*preferably alpha-cellulose in according to conventional practice,*" (col. 2, lines 36-43), as admitted in the Official Action as noted above. "*The print sheet 10 is provided with a suitable decorative print on its upper surface, in the illustrated embodiment, such printing being in the form of a leather-like coloring*" (col. 2, lines 44-46; emphasis added). Thus, the alpha-cellulose material comprising the print sheet has an upper surface that is printed to simulate a leather look. This disclosure does not meet the claimed feature of "*a first decorative layer consisting essentially of a leather material.*" Indeed there is no disclosure or suggestion whatsoever in the '978 Patent that the print sheet 10, or any other sheet for that matter disclosed therein, is of a leather material. As such, the '978 Patent is incapable of anticipating claim 1.

Applicants respectfully direct the Examiner to the advantages described on page 2 of the present specification as further evidence of the differences between the cited references and the claimed laminate.

In light of the foregoing, it is respectfully submitted that the anticipation rejection of independent claim 1 is moot and should be removed, and that claim 1 is in condition for allowance and should be passed to issuance.

11. Claims 1-6 are rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Pat. No. 3,700,537 (hereinafter the " '537 Patent").

Present independent claim 1 recites a heat and pressure consolidated laminate that comprises in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting resin; and b) a first decorative layer consisting essentially of a leather material.

The Official Action contends that the '537 Patent discloses "*a laminate comprising core sheets of kraft paper; a print sheet and an overlay sheet, both made of alpha-cellulose paper. The core sheets are impregnated with a phenol-formaldehyde resin, whereas the print or decorative sheet and the overlay sheet are impregnated with melamine-formaldehyde resin (See col. 1, ln. 55-71). The print sheet is with decorative printing, and is simulated leather (see col. 2, ln. 20-21), thus meeting the requirements of the presently claimed decorative layer.*" (Official Action pg. 5; emphasis added).

However, similar to the discussion above with respect to the '978 Patent, it is respectfully submitted that the '537 Patent fails to anticipate claim 1 because the '537 Patent fails to disclose a feature of claim 1, that of "*a first decorative layer consisting essentially of a leather material.*" (cl. 1, emphasis added). In contrast, all throughout the '537 Patent, including at the cited locations in the Official Action noted above, the '537 Patent discloses a laminate having an upper decorative surface with a pattern that provides an appearance that simulates leather. The laminate disclosed in the '537 Patent contains primarily paper sheets that comprise the various layers, and the laminate does not contain any actual leather material, as called for in claim 1. (See, for example, col. 2, lines 15-46).

The stated goal of the '537 Patent is "*to produce high pressure laminates with deeply embossed surfaces that duplicate natural products such as slate, leather and wood.*" (col. 2, lines 44-49; emphasis added). The '537 Patent discloses various prior art attempts (at that time) to form such an embossed surface. (See, for example, col. 1, line 39 through col. 3, line 57; FIGs. 1, 2A-2C). The '537 Patent then discloses a method for forming such an embossed surface in the laminate. (See, for example, col. 4, line 44 through col. 6, line 34; FIGs. 3A-3C). All throughout the '537 Patent, the various laminates comprise primarily paper materials, and the '537 Patent fails to disclose or suggest that any of the laminates may include a leather material, as called for in claim 1.

Further, as noted above the Official Action correctly contends that the '537 Patent discloses "*a laminate comprising core sheets of kraft paper; a print sheet and an overlay sheet, both made of alpha-cellulose paper. The core sheets are impregnated with a phenol-formaldehyde resin, whereas the print or decorative sheet and the overlay sheet are impregnated with melamine-formaldehyde resin (See col. 1, ln. 55-71). The print sheet is with decorative printing, and is simulated leather (see col. 2, ln. 20-21).*" (Official Action pg. 5; emphasis added). Thus, the Official Action admits that the '537 Patent discloses a laminate having paper sheets, where the laminate does not include a leather material.

Applicants respectfully direct the Examiner to the advantages described on page 2 of the present specification as further evidence of the differences between the cited references and the claimed laminate.

In light of the foregoing, the '537 Patent is incapable of anticipating claim 1. Therefore, it is respectfully submitted that the anticipation rejection of independent claim 1 is moot and should be removed, and that claim 1 is in condition for allowance and should be passed to issuance.

12-13. Claims 7 and 22-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over the ‘978 Patent or the ‘537 Patent in view of U.S. Pat. No. 2,732,325 (hereinafter the “ ‘325 Patent”) or U.S. Pat. No. 3,589,974 (hereinafter the “ ‘974 Patent”).

Present independent claim 7 recites a heat and pressure consolidated laminate, comprising in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting phenol-formaldehyde resin, said cellulosic sheet having a resin content ranging from about 25 percent to about 35 percent; b) a first decorative layer consisting essentially of a leather material, said first decorative layer is bonded leather having a sheet thickness ranging from about 0.2 mm to about 4.0 mm; and c) an overlay layer disposed on a side of said first decorative layer opposite the core layer, said overlay layer being at least one sheet of alpha cellulose paper impregnated with a melamine formaldehyde resin.

Present independent claim 26 recites a heat and pressure consolidated laminate, comprising in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting phenol-formaldehyde resin, the cellulosic sheet having a resin content ranging from about 25 percent to about 35 percent; and b) a first decorative layer consisting essentially of a leather material, the first decorative layer having a sheet thickness ranging from about 0.2 mm to about 4.0 mm.

Present independent claim 33 recites a heat and pressure consolidated laminate, comprising in superimposed relationship: a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting phenol-formaldehyde resin, the cellulosic sheet having a resin content ranging from about 25 percent to about 35 percent; and b) a first decorative layer consisting essentially of a leather material bonded to the core layer.

The Official Action contends that the ‘978 Patent and the ‘537 Patent “*are as set forth in claims 1-6 above and incorporated herein.*” (Official Action pg. 6). The Official Action then admits that neither the ‘978 Patent nor the ‘537 Patent “*discloses the amount of melamine-formaldehyde resin in the core sheet.*” (Official Action pg. 6). The Official Action contends that the ‘325 Patent or the ‘974 Patent each discloses an amount of melamine-formaldehyde resin in the core sheet, and concludes that it would have been obvious to combine the resin teachings of either the ‘325 Patent or the ‘974 Patent with the laminate teachings of either the ‘978 Patent or the ‘537 Patent to arrive at independent claims 7, 26 and 33. (Official Action pg. 6).

However, it is respectfully submitted that a *prima facie* case of obviousness has not been made out with respect to claims 7, 26 and 33. This is because of the lack of disclosure in both the '978 Patent and the '537 Patent of the claimed feature of "*a first decorative layer consisting essentially of a leather material.*" This feature is recited in each of claims 7, 26 and 33. The arguments with respect to this lack of disclosure are recited above with respect to the anticipation rejections of certain claims over the '978 and '537 Patents. In addition, independent claim 7 includes the feature of "*said first decorative layer is bonded leather.*" As neither the '978 Patent nor the '537 Patent disclose the feature of a leather material, it follows that neither patent discloses a "*bonded leather*" material.

When an application is submitted to the Patent and Trademark Office, statute¹ and case law² dictates that the burden of proof is on the PTO to establish a *prima facie* case of obviousness.³ Once the *prima facie* case has been established, then the burden of going forward with the evidence to rebut the *prima facie* case shifts to the applicant.⁴ Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden of persuasion remains with the PTO.⁵ In this instance, a *prima facie* case would necessarily have to first establish that the combined teachings of the '978 Patent or the '537 Patent with the '325 Patent or the '974 Patent render the claimed subject matter obvious⁶.

However, the prior art patents cited by the Examiner do not support the obviousness rejection of the independent claims 7, 26 and 33. This is for the simple fact that, as discussed in detail above, the '978 Patent and the '537 Patent both fail to disclose the claimed feature of "*a first decorative layer consisting essentially of a leather material.*" By omitting a material feature of a claim, the cited references cannot be combined as alleged by the Examiner to

¹ 35 U.S.C. 132.

² See *In re Warner*, 154 USPQ 173, 178 (C.C.P.A. 1967); *In re Oetiker*, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992).

³ *In re Piasecki*, 223 USPQ 785, 788 (Fed. Cir. 1984).

⁴ *In re Carleton*, 202 U.S.P.Q. 165,168 (CCPA 1979).

⁵ *Ashland Oil v. Delta Resins and Refractories, Inc.*, 227 U.S.P.Q. 657, 659 (Cir. Fed. 1985). See also *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Cir. Fed. 1992): "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. '[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' The patent applicant may then attack the Examiner's prima facie determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness.".

⁶ *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979) citing *In re Bozek*, 163 USPQ 545, 549-550 (C.C.P.A. 1969).

meet all of the features of the claims, and, thus, a *prima facie* case of obviousness cannot be made with respect to independent claims 7, 26 and 33.

In light of the foregoing, it is respectfully submitted that the obviousness rejection of claims 7 and 22-33 is now moot, and that claims 7 and 22-33 are in condition for allowance and should be passed to issuance.

As applicant has traversed all of the rejections made by the Examiner, it is respectfully requested that the stated rejections be withdrawn, claims 1-7 and 22-33 be allowed, and the present application be passed onto issuance. No additional fee is believed due with the present application. In the event a fee is due, please charge our Deposit Account No. 50-3381.

Respectfully submitted,



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